

REMARKS

Claims 1-18 are pending in the present application. Claims 1, 8, 15, and 17 are amended. Claims 1, 8, 15, and 17 are independent.

DRAWING OBJECTIONS

The Examiner has objected to the drawings because the reference number 210 has been used to designate two different steps in Figure 3. A Drawing Correction Authorization Request has been filed concurrently herewith in which the one of the steps has been relabeled with reference number 207. The specification has also been amended above in order to reflect the corrections to Figure 3. Accordingly, approval of the drawing correction and withdrawal of this objection is respectfully requested.

CLAIM OBJECTIONS

The Examiner has objected to claims 1, 8, 15, and 17 for informalities. Applicants have amended the claims as suggested by the Examiner. Applicants respectfully submit that these amendments do not change the scope of the claims. Nor were they made for a patentability reason. Rather, Applicants respectfully submit that the amendments are merely editorial in nature, and were made in order to correct minor informalities.

PRIOR ART REJECTIONS**Claims 1, 8, 15, 17**

Claims 1, 8, 15, and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,255,307 to Mizikovsky (hereafter Mizikovsky) in view of U.S. Patent No. 6,018,655 to Bartle et al. (hereafter Bartle). This rejection is respectfully traversed for the following reasons.

No Motivation to Combine Mizikovsky and Bartle

In section 6 of the Office Action, the Examiner asserts that Mizikovsky discloses a status indicator, which is activated if a received SID_R identifier does not match the stored SID_S identifier. In page 5, the Examiner acknowledges that Mizikovsky fails to disclose that the status indicator provides an audible or vibrating indication or alert to the user.

To remedy this deficiency, the Examiner imports the teachings of Bartle. The Examiner states that Bartle discloses both means for providing either a vibrating or audible alert to the user when an inter-system handoff is imminent.

The Examiner alleges that it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the audible or visual alerts of Bartle in Mizikovsky as additional means of alerting the user that a inter-system handoff is imminent "in order to enable the user to be aware of the mobile telephone status (i.e., roaming) without having the need to constantly look at a display of the mobile telephone to know the current status of

the telephone, [e]specially when the user is currently on a telephone call.”

The Examiner’s combination of Mizikovsky and Bartle is based on hindsight, using Applicants’ disclosure as a blueprint, which is not permitted. C.R. Bard, Inc. v. M3 Systems, 48 USPQ 1225 (CAFC 1998); Interconnect Planning Corp. v. Feil, 227 USPQ 543 (CAFC 1998); In re Rouffet, 47 USPQ2d 1453, 1459 (CAFC 1998).

Specifically, the Examiner’s stated motivation for combining the references (“...to enable the user to be aware of the [roaming] without having the need to constantly look at the display of the mobile telephone...”) has apparently been gleaned directly from Applicants’ own disclosure. The Examiner’s teaching of motivation is nearly identical to the teaching of page 1, lines 12-19, of Applicants’ specification, and the Examiner has provided no reference to any teaching in the prior art supporting this showing.

Applicants point out that teaching or motivation to combine references must be based on objective evidence of record, i.e., based on an analysis of the prior art. In re Lee, 61 USPQ2d 1430, 1433 (CAFC 2002). In determining the obviousness of an invention under 35 U.S.C. § 103, “[t]he issue...is whether the teachings of the prior art, *in and of themselves and without the benefits of [Applicant’s] disclosure*, make the invention as a whole, obvious.” In re Spinnoble, 160 USPQ 237, 243 (CCPA 1969).

Since the Examiner has not provided any such evidence showing a teaching or motivation to combine, but instead has merely used Applicants' disclosure as a blueprint, Applicants respectfully submit that the combination of Mizikovsky and Bartle is improper.

References Fail to Teach Every Feature

Even assuming for the sake of argument that proper motivation existed for combining Mizikovsky and Bartle, Applicants respectfully submit that the resultant combination fails to disclose every feature of claims 1, 8, 15, and 17. Specifically, none of the references teaches "determining whether a received identifier...is at least one of a collection of acceptable identifiers." As stated in MPEP § 2143.03, to establish *prima facie* obviousness, all claim limitations must be taught or suggested in the prior art.

In page 4 of the Office Action, the Examiner acknowledges that Mizikovsky fails to disclose this feature. However, the Examiner asserts tat it would have been "clearly obvious" to one of ordinary skill in the art to include a plurality of SIDs in Mizikovsky's disclosed memory because "Mizikovsky clearly disclose that the status indicator...is selectively controlled as the mobile station moves through services cells that are serviced by different providers (e.g., having different SID's)" (pages 4-5 of the Office Action).

Mizikovsky teaches that the mobile station's function is to determine whether or not the received control station was sent by a base station in its home system. If the mobile station determines that the

base station belongs to another system (service provider), it is the base station's function to determine whether the mobile station has a preferred (i.e., non-roaming) status. If the mobile station is granted this preferred status, the base station sends a control message controlling the status indicator. Accordingly, Mizikovsky specifically teaches away from using multiple identifiers at the mobile station to determine whether it has a non-roaming status within other service providers.

Applicants respectfully submit that the Examiner's proposed modification of Mizikovsky would change its principle of operation, and therefore is not sufficient to establish a *prima facie* case of obviousness. In re Ratti, 123 USPQ 349 (CCPA 1959) (as cited in MPEP § 2143.01). Further, Applicants respectfully submit that the proposed modification is improper, because the Examiner merely relies on conclusory statements, rather than a specific teaching or motivation, to make the proposed modification. Lee at 1433-34.

Accordingly, Applicants respectfully submit that a *prima facie* case of obviousness has not been established because the Examiner has failed to show that a teaching or suggestion for the determination of whether a received identifier is at least one of a collection of acceptable identifiers, as required by claims 1, 8, 15, and 17.

Claims 2-7, 9-14, 16, 18

Claims 2-7, 9-14, 16, and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mizikovsky in view of Bartle and U.S.

Patent No. 6,201,957 to Son et al. (hereafter Son). This rejection is respectfully traversed for the following reasons.

Applicants respectfully submit that the teachings of Son fail to remedy the deficiencies of Mizikovsky and Bartle discussed above with respect to independent claims 1, 8, 15, and 17.

In addition, Applicants hereby traverse the Examiner's statement that providing indications or commands via speech to a mobile telephone, using information provided in the mobile telephone's display, was notoriously well known at the time of the invention. Accordingly, Applicants respectfully request evidence, i.e., prior art, in the next Office Action supporting this statement. Applicants further point out that the Examiner has failed to provide a showing or motivation for modifying the combination of Mizikovsky, Bartle, and Son to incorporate this allegedly well known feature.

Accordingly, Applicants respectfully submit that claims 2-7, 9-14, 16, and 18 are allowable at least by virtue of their dependency on claims 1, 8, 15, and 17. Therefore, Applicants respectfully request reconsideration and withdrawal of this rejection.

CONCLUSION

In view of the above amendments and remarks, reconsideration of the various rejections and allowance of claims 1-18 is respectfully requested.

In the event that there are any outstanding matters remaining in the present application, the Examiner is invited to contact the undersigned at (703) 390-3030 in the Washington, D.C. area, to discuss this application.

Pursuant to the 37 C.F.R. 1.17 and 1.136(a), the Applicants respectfully petition for a two (2) month extension of time for filing a response in connection with the present application and the required fee of \$400.00 is attached hereto.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. 1.16 or under 37 C.F.R. 1.17; particularly, extension of time fees.

Respectfully submitted,

Harness, Dickey & Pierce, P.L.C.

By: 

Gary D. Yacura

Registration No. 35,416

GDY/JWR:kmh

P.O. Box 8910
Reston, Virginia 20195

Attachment: Version with Markings to Show Changes Made

VERSION WITH MARKINGS TO SHOW CHANGES MADE
IN THE SPECIFICATION

The paragraph beginning in line 5 of page 6 has been amended as follows:

If, on the other hand, the SID in the AHDM is listed in the SSPR database, then step 205 is reached, wherein the corresponding ROAM_IND field is checked to see if the analog SID meets a predetermined roaming notification criteria, which may be presettable by the user. Such criteria may be defined by whether a maximum per minute charge the user has programmed is exceeded, and/or whether an additional per call or per day charge would be incurred exceeding user programmed maximum amounts. If it is determined in step [210] 207 that the criteria for notification of the user are met, then step 206 is reached, which step has already been described. If, on the other hand, it is determined in step [210] 207 that the criteria for notification are not met, then step 100 is returned to in order to continue the control on Traffic Channel State.

IN THE CLAIMS

The claims have been amended as follows:

1. (Amended) A method for alerting a wireless terminal user of a handoff of a [cell] call from a first communication service station to a second communication service station, comprising the steps of:

receiving a handoff indicating message;

determining whether a received identifier of the second communication service station is at least one of a collection of acceptable identifiers; and

producing an audible alert during the call if the received identifier is not at least one of the collection of acceptable identifiers.

8. (Amended) A method for alerting a wireless terminal user of a handoff of a [cell] call from a first communication service station to a second communication service station, comprising the steps of:

receiving a handoff indicating message;

determining whether a received identifier of the second communication service station is at least one of a collection of acceptable identifiers; and

producing a vibrating alert during the call if the received identifier is not at least one of the collection of acceptable identifiers.

15. (Amended) A wireless terminal that alerts a user of a handoff of a call from a first communication service station to a second communication service station, comprising:

a receiver that receives a handoff indicating a message;

a memory containing a collection of acceptable identifiers; and

a processor that determines if a received identifier of the second communication service station is at least one of the collection of acceptable identifiers and activates an audible alert during the call if the

received identifier is not at least one of the collection of acceptable identifiers.

17. (Amended) A wireless terminal that alerts a user of a handoff of a call from a first communication service station to a second communication service station, comprising:

a receiver that receives a handoff indicating message;

a memory containing a collection of acceptable identifiers; and

a processor that determines if a received identifier of the second communication service station is at least one of the collection of acceptable identifiers and activates a vibrating alert during the call if the received identifier is not at least one of the collection of acceptable identifiers.